

**REMARKS**

In response to the Office Action mailed on September 18, 2007, Applicant respectfully requests reconsideration. Claims 1-30 and 32-34 are now pending in this Application. Claims 1, 17, 30 and 32 are independent claims and the remaining claims are dependent claims. In this Amendment, claims 1, 2, 5, 6, 17, 18, 21, 22, 30 and 32 have been amended and claim 31 has been cancelled and claims 33 and 34 have been added. Applicant(s) believe that the claim(s) as presented are in condition for allowance. A notice to this affect is respectfully requested.

**REJECTIONS under 35 U.S.C. § 112**

Claims 1-14 and 17-32 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicants have amended the claims to remove antecedent basis issues in the claims.

Withdrawal of the rejections is respectfully requested.

**REJECTIONS under 35 U.S.C. § 101**

Claims 1-14 and 17-32 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Office Action states the claims 1 and 30 do not produce a useful, concrete and tangible result. Applicant traverses this rejection for the following reasons:

- Claims 1 is directed to a process which is statutory subject matter (“process” as defined in 35 U.S.C. §101) and therefore the “useful, concrete and tangible result test” should not be applied; Claim 30 is directed to a “computer readable medium operable to store computer program,” which is statutory subject matter (“manufacture” as defined in 35 U.S.C. §101) and therefore the “useful, concrete and tangible result test” should not be applied

- The method claimed in claim 1 and manufacture of claim 30 do achieve a “useful, concrete and tangible result.”

According to the Guidelines, the first step in determining utility of a claim is to determine whether the claim is directed toward at least one of the enumerated subject matter categories — process, machine, manufacture or composition of matter. If the claims are not directed to one of the categories enumerated in 35 U.S.C. § 101, it should be determined whether the claim is directed to a law of nature, natural phenomena or abstract idea that constitute subject matter to which a judicial exception may apply. Finally, if it is determined that the claims are directed to one of the above-mentioned categories, PTO has proposed two ways to determine whether the claims are susceptible of an application of a § 101 judicial exception:

1. The claimed invention "transforms" an article or physical object to a different state or thing.
2. The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

Claim 1 is directed to a method and claim 30 is directed to a manufacture, so that the subject matter corresponds to a “process” and a “manufacture” respectively as recited in 35 U.S.C. §101. Therefore, applying the judicial exception test “useful, concrete and tangible result” is not an issue for these claims.

While the Applicant need not apply the judicial exception test “useful, concrete and tangible result” to the present claims, the claim 1 does produce a tangible result in that storing the computed fingerprint to generate a set of stored fingerprints is useful, concrete and tangible result.

Claims 17 and 32 have been amended to add “a processor comprising.” MPEP 2601(IV)(B)(2)(a) states “If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760.” Claims 17 and 32 now recite a combination of hardware and software.

As regards claim 30, the Specification has been amended to remove the reference to carrier waves and baseline signals.

As regards claim 31, the claim has been cancelled.

Withdrawal of the rejections is respectfully requested.

REJECTIONS under 35 U.S.C. § 103

Claims 1-3, 5, 9, 10, 14, 17-19, 21, 25, 26, 30 and 32 stand rejected under 35 U.S.C. § 103(a) as obvious over Applicant Admitted Prior Art (AAPA). The Applicant respectfully disagrees and traverses the rejection with an argument. On page 7 of the Office Action, it is asserted that the Application at page 2, lines 22-25 teaches “comparing the set of stored fingerprints to the set of comparison fingerprints to identify stored fingerprints matching at least one of the set of comparison fingerprints and, if a match is found, **identifying a previous incoming transmission** corresponding to a matching stored fingerprint of the set of stored fingerprints,” as in amended claim 1 (Emphasis added). The cited text states “[s]uch conventional virus detection applications, therefore, employ a set of known virus fingerprints for comparison with incoming mail messages.” But, the cited text is silent as to previous incoming transmissions, which are different than incoming transmissions. To buttress this argument, the Examiner is directed to page 3 lines 3-10 of the Application, wherein it states

The present invention is based, in part, on the observation that typical **conventional virus detection software monitors incoming arrivals of network traffic. Retroactive analysis and/or monitoring of previously accepted traffic is not included in the scope of protection.** Further, conventional approaches do not maintain a propagation history or other indication of successive dissemination of a potentially harmful transmission, such as other users to whom the recipient forwards the message. Therefore, remedial action or other mitigation against a harmful or undesirable transmission is difficult. [Emphasis added]

Thus, the AAPA specifically states that prior art teaches away from “identifying a previous incoming transmission,” as in the claims as the AAPA teach retroactive

analysis and/or monitoring of previously accepted traffic is not included in the scope of protection of conventional virus detection software.

Likewise, claim 17, 30 and 32 do not teach or suggest “a comparator operable to compare the set of stored fingerprints to the set of comparison fingerprints to identify stored fingerprints matching any of the set of comparison fingerprints and, if a match is found, identifying a previously processed incoming transmission corresponding to a matching stored fingerprint of the set of stored fingerprints,” as in amended claim 17, “computer program code for comparing the set of stored fingerprints to the set of comparison fingerprints to identify stored fingerprints matching any of the set of comparison fingerprints and, if a match is found, identifying a previously received incoming transmission corresponding to a matching stored fingerprint of the set of stored fingerprints,” as in amended claim 30, or “a means for comparing the set of stored fingerprints to the set of comparison fingerprints to identify stored fingerprints matching any of the set of comparison fingerprints and, if a match is found, identifying a previously received incoming transmission corresponding to the matching stored fingerprint of the set of stored fingerprints,” as in amended claim 32.

Further, on pages 7 and 8, the Office Admits that the AAPA does not teach or suggest “storing the computed fingerprint to generate a set of stored fingerprints,” as in amended claim 1. But, the Office asserts that it would be obvious to one of ordinary skill in the art to do so. The Applicant disagrees. It is not necessary to store the computed fingerprint, as it could be directly compared without first storing it. Further, the Office’s assertion seemed to be based at least on personal knowledge of the Examiner. 37 C.F.R. § 1.104(d)(2) requires such an assertion to be supported with an affidavit when called for by the Applicant. Thus, Applicant calls for support for the assertion with an affidavit. If the Office is taking Official Notice of its assertion, the Applicant requests that the Office explicitly state such in any future Office Action in which the rejection based on the obviousness is maintained.

For at least the reasons stated above, the AAPA fails to teach or suggest the features of independent claims 1, 17, 30 and 32 or the claims dependent therefrom.

As regards claims 2 and 18, on page 8 of the Office Action it is asserted that the Application page 2 lines 19-22 teaches or suggest “selectively storing, if the incoming transmission does not correspond to the set of comparison fingerprints, at least one fingerprint corresponding to the at least one identifiable portion of the incoming transmission.” As discussed, the prior art does not look at previous incoming emails, therefore there is not need in the prior art to store if the incoming transmission does not correspond to the set of comparison fingerprints.

As regards claims 9 and 25, on page 8 of the Office Action it is asserted that the Application page 2 lines 19-25 teaches or suggest “the determined undesirable portion did not indicate undesirable transmissions based on the comparing of a previous set of comparison fingerprints.” The cited text does not teach or suggest “the determined undesirable portion did not indicate undesirable transmissions based on the comparing of a previous set of comparison fingerprints.” The Application at page 2 lines 19-21 states “[t]he conventional virus detection application also computes a signature for portions of incoming messages for comparison, such that message portions yielding a similar fingerprint are deemed to be harmful,” which is the opposite of the claimed feature.

Claims 4, 6-8, 11-13, 20, 22-24 and 27-29 stand rejected under 35 U.S.C. § 103(a) as being obvious over AAPA and Paul, U.S. Patent No. 6,052,709. For at least the reasons stated above, the combination of AAPA and Paul fail to teach or suggest the features of claims 4, 6-8, 11-13, 20, 22-24 and 27-29.

Withdrawal of the rejections is respectfully requested.

#### NEW CLAIMS

Dependent claims 33 and 34 are new. Support for claims 33 and 34 found on page 3 lines 5 and 6. The Applicant submits that no new matter has been added by the addition of claims 33 and 34. The prior art failing to teach or suggest identifying a previously processed incoming transmission corresponding to a matching stored

fingerprint of the set of stored fingerprints is a retroactive analysis of a previously accepted transmission.

SUMMARY

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. It is believe that no new matter has been added. An early action to that effect is courteously solicited.

Applicant(s) hereby petition(s) for any extension of time which is required to maintain the pendency of this case. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50-3735.

If the enclosed papers or fees are considered incomplete, the Patent Office is respectfully requested to contact the undersigned collect at (508) 616-9660, in Westborough, Massachusetts.

Respectfully submitted,

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